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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/783,521

02/20/2004

Minoru Goda

7985/7

7165

7590 07/07/2008  
Brinks Hofer Gilson & Lione  
P.O. Box 10395  
Chicago, IL 60610

EXAMINER

TOLIN, MICHAEL A

ART UNIT

PAPER NUMBER

1791

MAIL DATE

DELIVERY MODE

07/07/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/783,521	<b>Applicant(s)</b> GODA, MINORU	
	<b>Examiner</b> MICHAEL A. TOLIN	<b>Art Unit</b> 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8, 10, 12 and 13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8, 10, 12 and 13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1 and 12 are rejected under 35 U.S.C. 102(b) as being anticipated by Komatsu'420 (US 6467420).

Komatsu'420 teaches a method of making a three-dimensional embroidery product comprising the steps of providing a base layer, an intermediary layer and a top layer, embroidering a pattern through the layers with thread, and cutting and removing in an acclaimed manner (column 3, lines 56-67; column 4, lines 1-8).

Regarding claim 12, Komatsu'420 teaches the claimed heating step (column 3, lines 12-23).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komatsu'420 as applied to claims 1 and 12 above, and further in view of Tajima (US 6263817).

Tajima is applied as set forth in numbered paragraph 4 of the previous office action mailed 09 October 2007.

5. Claims 3-6, 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Komatsu'420 as applied to claims 1 and 12 above, and further in view of Jalowsky (US 4517910).

Jalowsky is applied as set forth in numbered paragraph 5 of the previous office action.

Regarding the temperature limitation of claim 13, this temperature corresponds to about 300°F. Jalowsky suggest temperatures of 250°F to 350°F and prefers a range of 250°F to 300°F. The claimed temperature is within both the suggested and preferred ranges. Accordingly, one of ordinary skill in the art would have been expected to heat to a temperature of 150°C as a matter of routine experimentation in order to suitably activate the selected fusible film in view of the range of temperatures suggested by Jalowsky.

6. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Komatsu'420 as applied to claims 1 and 12 above, and further in view of Fortuna (US 6718895).

Fortuna is applied as set forth in numbered paragraph 6 of the previous office action.

7. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Komatsu'420 as applied to claims 1 and 12 above, and further in view of JP 2000-64183.

JP 2000-64183 is applied as set forth in numbered paragraph 7 of the previous office action.

### ***Response to Arguments***

8. It is noted that the submitted declaration filed 08 April 2008 to antedate Komatsu'676 (WO 03/024676) is not persuasive for the reasons discussed below. However, in the interest of compact prosecution, a further search was performed and new prior art has been applied. As to the declaration, MPEP 715.07 requires that a declaration to antedate a reference provide factual evidence to establish conception and reduction to practice of the claimed invention. The only factual evidence submitted by the declaration are two pictures of embroideries showing a face of a bear. These pictures do not clearly show the steps of providing, cutting, and removing set forth in claim 1. Mr. Goda's statement 5 that the embroidery shown by the pictures was produced in the claimed manner amounts to a general allegation and does not set forth factual evidence. Additionally, the declaration does not set forth an allegation that the

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acts relied upon to establish the date were carried out in this country, a NAFTA country, or a WTO member country. See MPEP 715.07(c).

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL A. TOLIN whose telephone number is (571)272-8633. The examiner can normally be reached on M-F 9am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Crispino can be reached on 571-272-1226. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael A Tolin/  
Examiner, Art Unit 1791

/Richard Crispino/  
Supervisory Patent Examiner, Art Unit 1791